APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/894,035	06/28/2001	Michael Baentsch	CH920000039US1 (14665)	5498

7590 04/19/2006	EXAMINER
Steven Fischman, Scully, Scott, Murphy & Presser 400 Garden City Plaza Garden City, NY 11530	FAROOQ, MOHAMMAD O

ART UNIT	PAPER NUMBER
2181	

DATE MAILED: 04/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	09/894,035	BAENTSCH ET AL.
	Examiner	Art Unit	
	Mohammad O. Farooq	2181	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *15 November 2005*.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-13 and 15-19* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-13 and 15-19* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *28 June 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some *   c)☒ None of:

      1.☒ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

FRITZ FLEMING
Supervisory PRIMARY EXAMINER
GROUP 2100
AU 2181
4/14/2006

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

1.   Claims 1-13 and 15-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Nachenberg, U.S. Pat. No. 6,230,316 B1 in view of Shaw, U.S. 2002/0026634 A1.

2.   As to claim 1, Nachenberg teach computer-implemented method for a software provider

(25) of enabling a software-acquiring entity (20) to arrive from an existent first piece of code

(11) executable on a machine at a second piece of code (12,13), executable on the machine, both

pieces of code (11,12,13) having been granted by use of a first software archive generator (2)

under use of generation instructions (8), comprising the step of

        providing to said software-acquiring entity (20) a difference code (4,5) (i.e. difference

between two versions; col. 1, lines 34-52), said difference code comprising the steps necessary to

arrive from said first piece of code (11) at said second piece of code (12,13), said difference code

(4,5) (i.e. difference between two versions; col. 1, lines 34-52) is usable at said software-

acquiring entity (20), and

combining said difference code with said first piece of code (11) by a second software

archive generator (7) to generate said second piece of code (11) by a second software archive

generator (7) to generate said second piece of code (12, 13), whereby said second software

archive generator (7) is to be fed with those generation instructions (8) that were used by said

first software archive generator (2) for the generation of both pieces of code (11, 12, 13)

(abstract; fig. 8; col. 5, line 36- col. 6, line 17).

However, Nachenberg does not teach signed pieces of code. Shaw teaches signed pieces

of code (digital signatures in downloaded code; paragraph 0030). Therefore, it would be obvious

to one of ordinary skill in the art at the time of invention to combine the teachings of Nachenberg

and Shaw because that would provide trustworthy information with which to perform software

and data integrity tests, and with which to locate data for recovery or upgrade of the client device

(paragraph 0009).

3.   As to claim 2, Nachenberg teach computer-implemented method, wherein the generation

instructions (8) are provided to the software-acquiring entity (20) by the software provider (25),

together with the second software archive generator (7) (inherent; col. 1, lines 12-26).

4.   As to claim 3, Nachenberg does not teach pieces of code (11,12, 13) are signed using a

private key (14). Shaw teaches pieces of code are signed using a private key (due to digital

signatures in downloaded code; paragraph 0030). Therefore, it would be obvious to one of

ordinary skill in the art at the time of invention to combine the teachings of Nachenberg and

Shaw because that would provide trustworthy information with which to perform software and

data integrity tests, and with which to locate data for recovery or upgrade of the client device

(paragraph 0009).

5.   As to claim 4, Nachenberg teach computer-implemented method, wherein the pieces of

code (11, 12, 13) are stored in a storage unit (1) at the software provider (25) (see fig. 8; col. 1,

lines 12 – 59).

        Nachenberg does not teach signed pieces of code. Shaw teaches signed pieces of code

(digital signatures in downloaded code; paragraph 0030). Therefore, it would be obvious to one

of ordinary skill in the art at the time of invention to combine the teachings of Nachenberg and

Shaw because that would provide trustworthy information with which to perform software and

data integrity tests, and with which to locate data for recovery or upgrade of the client device

(paragraph 0009).

6.   As to claim 5, Nachenberg teach computer-implemented method, wherein the difference

code (4,5) (i.e. incremental updates) is created, by the first software archive generator (2), while

said first software archive generator (2) generates the second piece of code (12, 13) (inherent;

col. 1, line 34 – col. 2, line 24).

Nachenberg does not teach signed pieces of code. Shaw teaches signed pieces of code (digital signatures in downloaded code; paragraph 0030). Therefore, it would be obvious to one of ordinary skill in the art at the time of invention to combine the teachings of Nachenberg and Shaw because that would provide trustworthy information with which to perform software and data integrity tests, and with which to locate data for recovery or upgrade of the client device (paragraph 0009).

7.   As to claim 6, Nachenberg teach computer-implemented method, wherein for more than two pieces of code (11, 12, 13) being stored, the difference code (4,5) is generated only between a subset of said pieces of code (11, 12, 13) (inherent; see fig. 8).

8.   As to claim 7, Nachenberg teach computer-implemented method, wherein for arriving from the first piece of code (11) to the second piece of code (13) several difference codes (4, 5) are required, these difference codes (4,5) are merged into a single difference code (i.e. update file; see fig. 8) to be provided to the software-acquiring entity (20) (col. 1, line 53 – col. 2, lines 24; col. 5, line 34 – col. 6, line 17).

9.   As to claim 8, Nachenberg teach computer-implemented method, wherein the first and second piece of code (11, 12, 13) are identified at the software provider (25) by deriving a corresponding identifier from a request (16) received from the software-acquiring entity (20) (inherent; col. 1, line 12 – col. 2, line 24).

10.   As to claim 9, Nachenberg teach computer-implemented method for a software-acquiring

entity (20) of arriving from an existent first piece of code (11) executable on a machine at a

second piece of code (12, 13), executable on the machine, both pieces of code (11, 12, 13)

having been generated at a software provider (25) by use of a first software archive generator (2)

under use of generation instructions (8), comprising the steps of

-       sending a code amendment request (16) to said software provider (25) for the delivery of

a difference code (4,5) which comprises the steps necessary to arrive from said first piece of

code (11) at said second piece of code (12, 13) (inherent; col 1, lines 34-52),

-       receiving said difference code (4,5) (i.e. update; fig. 8; col. 1, line 12 – col. 2, line 24),

-       combining said difference code (4,5) with said first piece of code (11) by use of a second

software archive generator (7), thereby generating said second piece of code (12, 13), whereby

said second software archive generator (7) is fed with those generation instructions (8) that were

used by said first software archive generator (2) for the generation of both pieces of code (11, 12,

13) (col. 1, line 34 – 52; col. 5, line 36 – col. 6, line 17).

Nachenberg does not teach signed pieces of code. Shaw teaches signed pieces of code

(digital signatures in downloaded code; paragraph 0030). Therefore, it would be obvious to one

of ordinary skill in the art at the time of invention to combine the teachings of Nachenberg and

Shaw because that would provide trustworthy information with which to perform software and

data integrity tests, and with which to locate data for recovery or upgrade of the client device

(paragraph 0009).

11.   As to claim 10, Nachenberg teach computer-implemented method, wherein the

generation instructions (8) are received from the software provider (25), together with the second

software archive generator (7) (inherent; col. 1, lines 12-26).

12.   As to claim 11, Nachenberg teach computer-implemented method, wherein the pieces of

code (11, 12, 13) are signed by use of a private key (14) and the signature (Sig 11, Sig 12, Sig

13) is verifiable by use of a corresponding public key (15) (inherent; col. 1, line 65 – col. 2, lines

24).

13.   As to claim 12, Nachenberg teach computer-implemented method, wherein the first and

second pieces of code (11, 12, 13) are identified by the software-acquiring entity (2) by giving a

corresponding identifier in the code amendment (i.e. update) request (16) (col. 1, line 12 – col.

2, line 24; col. 5, line 34 – col. 6, line 17).

14.   As to claim 13, Nachenberg teach program storage device readable by a machine,

tangibly embodying a program of instructions executable by the machine to perform method for

        a software provider (25) of enabling a software-acquiring entity (20) to arrive from an

existent first piece of code (11) executable on a machine at a second piece of code (12,13),

executable on the machine, both pieces of code (11,12,13) having been granted by use of a first

software archive generator (2) under use of generation instructions (8), comprising the step of

providing to said software-acquiring entity (20) a difference code (4,5) (i.e. difference

between two versions; col. 1, lines 34-52), said difference code comprising the steps necessary to

arrive from said first piece of code (11) at said second piece of code (12,13), said difference code

(4,5) (i.e. difference between two versions; col. 1, lines 34-52) is usable at said software-

acquiring entity (20), and

combining said difference code with said first piece of code (11) by a second software

archive generator (7) to generate said second piece of code (11) by a second software archive

generator (7) to generate said second piece of code (12, 13), whereby said second software

archive generator (7) is to be fed with those generation instructions (8) that were used by said

first software archive generator (2) for the generation of both pieces of code (11, 12, 13)

(abstract; fig. 8; col. 5, line 36- col. 6, line 17).

Nachenberg does not teach signed pieces of code. Shaw teaches signed pieces of code

(digital signatures in downloaded code; paragraph 0030). Therefore, it would be obvious to one

of ordinary skill in the art at the time of invention to combine the teachings of Nachenberg and

Shaw because that would provide trustworthy information with which to perform software and

data integrity tests, and with which to locate data for recovery or upgrade of the client device

(paragraph 0009).

15.   As to claim 15, Nachenberg teach code amendment enabler tangibly embodied in

hardware for enabling a software-acquiring entity (20) to arrive from an existent first piece of

code (11) at a second piece of code (12,13), both pieces of code (11,12,13) having been

generated by use of a first software archive generator (2) under use of generation instructions (8),

comprising

-        a difference code generator (10) for generating a difference code (4,5) that comprises the

steps necessary to arrive from said first piece of code (11) at said second piece of code (12, 13),

which difference code (4,5) is usable at said software-acquiring entity (2) to be combined with

said first piece of code (11) by a second software archive generator (7) to generate said second

piece of code (12, 13), whereby said second software archive generator (7) is fed with the

generation instructions (8) (abstract; fig. 8; col. 1, line 12- col. 6, line 24; col. 5, line 36 – col. 6,

line 17),

-        an output unit (3) for providing to said software-acquiring entity (2) said difference code

(4,5) (inherent; see fig. 8; col. 5, line 36 – col. 6, line 17).

Nachenberg does not teach signed pieces of code. Shaw teaches signed pieces of code

(digital signatures in downloaded code; paragraph 0030). Therefore, it would be obvious to one

of ordinary skill in the art at the time of invention to combine the teachings of Nachenberg and

Shaw because that would provide trustworthy information with which to perform software and

data integrity tests, and with which to locate data for recovery or upgrade of the client device

(paragraph 0009).

16.   As to claim 16, Nachenberg teach code amendment enabler tangibly embodied in

hardware, further comprising an input unit (24) (inherent) for receiving from said software-

acquiring entity (20) a code amendment request (16) for the delivery of said difference code (4,5)

(col. 5, line 36 – col. 6, line 17).

17.   As to claim 17, Nachenberg teach code amendment enabler tangibly embodied in

hardware, further comprising a first software archive generator (2) for generating said pieces of

code (11, 12, 13) under use of generation instructions (8) (col. 1, lines 12 – 65).

18.   As to claim 18, Nachenberg teach code amendment device tangibly embodied in

hardware for arriving from an existent first piece of code (11) at a second piece of code (12, 13),

both pieces of code (11, 12, 13) having been generated at a software provider (25) by use of a

first software archive generator (2) under use of generation instructions (8), comprising:

a second software archive generator (7) for combining a received difference code (4,5)

with said first piece of code (11), thereby generating said second piece of code (12, 13) ,

whereby said second software archive generator (7) is to be fed with those generation

instructions (8) that were used by said first software archive generator (2) for the generation of

both pieces of code (11, 12, 13) (inherent; col. 1, line 12 – col. 2, line 24; col. 5, line 36 – col. 6,

line 17).

Nachenberg does not teach signed pieces of code. Shaw teaches signed pieces of code (digital signatures in downloaded code; paragraph 0030). Therefore, it would be obvious to one of ordinary skill in the art at the time of invention to combine the teachings of Nachenberg and Shaw because that would provide trustworthy information with which to perform software and data integrity tests, and with which to locate data for recovery or upgrade of the client device (paragraph 0009).

19.   As to claim 19, Nachenberg teach code amendment device tangibly embodied in hardware, further comprising an input/output unit (6) for sending a code amendment request (16) to said software provider (25) and for receiving said difference code (4,5) (inherent since updates are developed and sent via floppy or CD-ROMs; col. 1, line 12 – 26).

Response to Arguments

20.   Applicant's arguments with respect to claims 1-13 and 15-19 have been considered but are moot in view of the new ground(s) of rejection.

21.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Mohammad O. Farooq whose telephone number is (571) 272-

4144. The examiner can normally be reached on 8:00am - 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Fritz M. Fleming can be reached on (571) 272-4145. The fax phone number for the

organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

FRITZ FLEMING
Supervisory/PRIMARY EXAMINER 4/14/2006
GROUP 2100
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Mohammad O. Farooq
April 10, 2006